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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/346,859 07/02/99 ROCKSTEIN

G 1274.024G

EXAMINER

MM91/1015

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NEW YORK NY 10165

SANDERS, A

ART UNIT

PAPER NUMBER

2876
DATE MAILED:

4
10/15/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/346,859

Applicant(s)

ROCKSTEIN ET AL.

Examiner

Allyson N Sanders

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-84 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-35 and 60-84 is/are allowed.
- 6) ☒ Claim(s) 36-59 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2. 6) ☐ Other: _____.

DETAILED ACTION

Specification

1. The disclosure is objected to because of the following informalities:

Pages 7 and 10 of the specification are cut off and not fully legible.

Many of pages throughout the specification are cut off at the top of the page and some of the words are legible.

Appropriate correction is required.

Double Patenting

2. Claim 36 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 4, 18, and 24 of U.S. Patent No. 5,886,337 hereinafter '337. Claims 1, 4, 18, and 24 recite the same bar code symbol reading system as set forth in claim 36 of USPN '337 patent.

The applicant's claim a bar code symbol reading system comprising a hand-supportable housing having a handle and head portion; an activatable laser beam source, when activated, a visible laser beam is directed through a transmissive window; an activatable scanning mechanism; a light and object detection means; a processing means for processing produced scan data in order to detect and decode the bar code symbol on the detected object; a control means; a means for automatically activating the activatable laser beam source; and a means for automatically deactivating the activatable laser. The only difference between the present claimed invention and of 'the 337 patent is the utilization of different terminologies and/or rephrasing of the

terminologies. The Examiner believes that the scope of claim 36 of the present application, and claims 1, 4, 18, and 24 of the '337 patent are almost identical but differ only in terminology and/or phrasing of terminology.

Thus, with respect to above discussions, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to utilize the teachings of claims 1, 4, 18, and 24 of the '337 patent and modify the terminology and the phrasing of the claims.

The obviousness-type double patenting rejection is a judicially established doctrine based upon public policy and is primarily intended to prevent prolongation of the patent term by prohibiting claims in a second patent not patentably distinct from claims in a first patent. *In re Vogel*, 164 USPQ 619 (CCPA 1970). A timely filed terminal disclaimer in compliance with 37 C.F.R. § 1.32(b) would overcome an actual or provisional rejection on this ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 C.F.R. § 1.78(d)

Allowable Subject Matter

3. Claims 37-59 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

4. The following is a statement of reasons for the indication of allowable subject matter:

5. The following is an Examiner's statement of reasons for the indication of allowable subject matter. The prior art of record, taken alone or in combination, fail to teach or fairly suggest the specific limitations such as the short-range and long-range mode of object detection; the specific stand for receiving and supporting the laser scanning device; the support base and frame used for detection means and the magnetic field which is generated by the support frame; and finger accommodating recess; a first and second ferrous element; a first and second magnetic element; and the adaptor module. Moreover, one of ordinary skill in the art would not have been motivated to come to the claimed invention.

6. Claims 1-35 and 60-84 are allowable over the prior art of record.

7. The following is an examiner's statement of reasons for allowance:

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Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance." The best prior art taken of record teaches, a bar code scanning and reading system but it fails to teach or fairly suggest the specific limitations of the stand for receiving and supporting the hand-supportable laser scanning device, the bar code symbol scanning system, the bar code symbol reading system, and the automatic bar code symbol reading system. Moreover, one of ordinary skill would not have been motivated to come to the above claimed invention.

8. As allowable subject matter has been indicated, applicant's response must either comply with all formal requirements or specifically traverse each requirement not complied with. See 37 C.F.R. § 1.111(b) and section 707.07(a) of the M.P.E.P.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Swartz et al (4,897,532) and JP (403174681) Katayama et al (US 5418353) discloses an reader/writer apparatus, an antenna for reader/writer, and a non-contact IC card respectively.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to *Allyson Sanders* whose telephone number is (703) 305-5779. The examiner can normally be reached between the hours of 7:30AM to 4:00PM Monday thru Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee, can be reached on (703) 305-3503. The fax phone number for this Group is (703) 308-7722, (703) 308-7724, or (703) 308-7382.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [allyson.sanders@uspto.gov].

All Internet e-mail communications will be made of record in the application file.

PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published

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in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG
89.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0956.

AS

Allyson Sanders
Patent Examiner
Art Unit 2876
October 3, 2001

A handwritten signature in black ink, appearing to read 'Karl D. Frech', written in a cursive style.

KARL D. FRECH
PRIMARY EXAMINER